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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,178	06/20/2003	J. Kirk Haselden	MSFT-1741 (301923.01)	9748
41505 7590 09/18/2009 WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION) CIRA CENTRE, 12TH FLOOR 2929 ARCH STREET PHILADELPHIA, PA 19104-2891				
EXAMINER				
VU, TUAN A				
ART UNIT		PAPER NUMBER		
2193				
MAIL DATE		DELIVERY MODE		
09/18/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action
Before the Filing of an Appeal Brief

Application No.

10/600,178

Applicant(s)

HASELDEN ET AL.

Examiner

TUAN A. VU

Art Unit

2193

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED ~~28 August 2009~~ FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-10 and 15-22.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Tuan A Vu/
Examiner, Art Unit 2193

Continuation of 11, does NOT place the application in condition for allowance because:
the previous Office action has indicated as following:

1) Applicants have submitted that a declaration under 37 CFR § 1.131 is "attached hereto", whereby declaring that Nara (effective priority date of March 3 2003) does not qualify as prior art (Appl. Rmrks pg. 6, top). A closer look at any corroborating facts regarding the 'attached hereto' statement, it is observed that there is no proper execution of an Affidavit in a form compliant with said CFR. That is, using pleading inside an "Applicant's Remarks" cannot constitute a formal substitute for a formal declaration which should be executed with signature of declarant and fulfillment of all required terms defined under this rule. The declaration per se is deemed not present and the above pleading (effectuated inside a 'Applicant's Remarks') that Naha does not constitute prior art cannot be honored.

Applicants have submitted invoice (redacted form) of a law firm to show diligence according to MPEP § 715.07 II, § 2138.06 as evidence to showing that 'work' has been sustained from a period prior to 3/3/03 to June 2003 (Appl. Rmrks, pg. 6-7). However, there is no legal oath or declaration provided for the Office to ascertain whether as executed the affidavit under CFR § 1.131 would be exercising option (a) with inventor's owning subject matter prior to an effective prior date or option (b) with inventor's showing prior conception via sustained diligence (by character and weight facts) prior to an effective prior date.

2).
According to option b, conception of an invention from a date (or time) declared (sworn via a proper execution of the Affidavit) as prior to an effective date would have to be supported by evidence of weight (emphasis added) that show that work had been more or less continuous from the sworn time up until 6/20/2003 date of reduction to practice. The 'redacted' copy provided shows a 'case administration' 2/4/03 and 'Received and began study of Disclosure Materials' 3/7/2003. First, there is one month gap between 2/4 and 3/03/03 which is unexplained. Further, in the hypothetical case where the Affidavit is executed under option b), the fact that a case is administered at date 2/4/03 does not show weight and character (emphasis added) that the inventor (or Microsoft) had started to conceive the subject matter (e.g. a date "sworn by a proper declaration") and then provided work up to the time when the law firm received the "disclosure materials" (3/7/03) and then beyond such time. Suppose that the date (conception date or time *) sworn by the oath (not a statement inside an Arguments section) is properly executed, the amount of work up the actual 6/20 date would have to be shown (without a significant unexplained gap of non-activity) as dated representation of work or exhibits, all of which reasonably conveying continuity of (inventor or Microsoft) activities starting from the time (e.g. time *) of initial conception of the claimed subject matter through 3/03/2003 and up to June 2003 (reduction to practice) as raised above. Such provision is not deemed achieved in the current Applicant's response.

In short, based on the current submission, no effort is provided to cure to the deficiencies raised in the above observations 1) and 2) The verbal pleading or maintaining that the redaction with date showing applicants' waiting for attorney's response to communication constitutes clear diligent effort does not actually amount to a legal ground established from a compliant, explicit and proper execution of a declaration; i.e. using option a) or b) where diligence (option b as declared) from conception has to be followed by continual effort towards constructive reduction. In the event that option b) were declared, the date of 'actual reduction to practice' or "conception" would serve as starting point for one to consider whether diligence has been applied timely. This diligence cannot be recognized, as per this current submission, by mere pleading when there is no formal 1.131 affidavit including specific legal language or execution format. From the 'conception' date as sworn in said compliant format, evidence that inventor had exercised all reasonable effort in reducing his conception into a 'constructive reduction' should be provided, and any gap of time or silent period of activity should be explained not by pleading (e.g. that nearly a month of waiting constitutes strong evidence that actual diligence exists or existed) but preferably by more facts. For example, silent period of waiting cannot strongly support ongoing effort provided by the inventive entity to further up the conceived invention, especially when the exhibit (DTS Deployment) provided regarding work achieved does not establish ownership via author names with dated works.

The rejection using Naha will be maintained because no affidavit under the CFR 1.131 (a, or b) was filed as a starting point to establishing diligence. The amendment to claim 21 will be entered, since it is not affecting any allowability state of the case.